

## REMARKS/ARGUMENTS

### *Status of the claims*

Claims 1 – 4, 6 – 12, and 16 – 24 are pending in the application. Claims 1, 3, 7 – 12, and 17 - 22 have been amended to comply with the Examiner's prior objections and to overcome the Examiner's prior rejections. Claims 5 and 13 - 15 have been cancelled.

### *Introduction*

In Examiner's July 18, 2005 Office Action, the Examiner: rejected all claims as being directed toward non-statutory subject matter under 35 U.S.C. § 101; objected to the drawings under 37 CFR 1.83(a); rejected all claims under 35 U.S.C. § 112 because of the use of indefinite terminology; rejected all claims under 35 U.S.C. § 103; and rejected the 1.131 affidavits of Lopez and Rodriguez as being ineffective to establish conception, diligence, or reduction to practice.

### *35 U.S.C. § 101 Rejection*

Examiner rejected all claims under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. Examiner's analysis relied on a "technological arts" test. Applicant respectfully directs the Examiner's attention to a recent decision by the Board of Patent Appeals and Interferences which explicitly rejects the notion that such a "technological arts" test exists. "Our determination is that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." Ex Parte Lundgren, 2004 WL 3561262, p. 5, 76 U.S.P.Q. 1385 (Bd. Pat. App. & Interf. April 20, 2004).

The Examiner also rejects the claims based on a finding that the invention does not produce a “useful, concrete, and tangible result.” Examiner points to certain language, such as “record,” “profile,” and “interface,” that indicates that the system in question is a software system. These terms are well-known in the industry to refer to both software and algorithms, both of which are clearly within the bounds of patentable subject matter.

Applicant respectfully requests that the Examiner withdraw all rejections based on 35 U.S.C. § 101.

### ***Objection to Drawings***

Examiner objected to the drawings under 37 CFR 1.83(a) as failing to show all the features specified in the claims. Applicant has replaced the term “purchasing interface” with “purchaser interface” throughout the claims to address this objection.

### ***35 U.S.C. § 112 Rejections***

Examiner rejects all claims as being indefinite under 35 U.S.C. § 112, ¶ 2. The Examiner is primarily concerned the use of labels applied the term “product;” multiple references to the action of ordering in Claim 1; the use of the terms “record,” “profile,” “interface,” and “server site;” use of the term “enable;” and use of the terms “predeterminable” and “predefined.”

Applicant has amended the claims to eliminate confusion over the labels used to refer to “product.” Applicant has also eliminated the multiple references to the action of ordering in Claim 1. While the Applicant contends that there is nothing indefinite about the term “enable,” Applicant has nonetheless changed this term to “allow” in the Claims.

The terms “record,” “profile,” “interface,” and “server site” are well-known in the art and in fact are widely used in patents referring to software, algorithms, or business methodology.

Examiner argues that the terms “predeterminable” and “predefined” refer to actions that take place outside of the bounds of the Claims and are therefore indefinite. Applicant urges that Examiner to consider the terms in the following light. The use of “predeterminable” and “predefined” are intended to indicate that the profile and information content, respectively, *may be* established outside the system, such as from another database. In this respect, they are no different from any raw material used in any other physical or business methodology invention. The inventive concept of the present application deals with how the system encompasses, operates on, stores, and manages these underlying “raw materials.”

Based on the foregoing amendment and arguments, Applicant respectfully requests that the Examiner withdraw all rejections based on 35 U.S.C. § 112.

### ***35 U.S.C. § 103 Rejections***

Examiner rejects all claims under 35 U.S.C. § 103(a) as being unpatentable over SEC filing of 12 May 1999 by ImageX.com, downloaded from the Internet on 15 October 2004.

Applicant respectfully disagrees with the Examiner’s interpretation of the prior art and the present invention in several respects. First, Examiner repeatedly refers to Page 5 of the SEC filing in finding prior disclosure of an interface which prevents a user from altering company-indicative information. However, in the Examiner’s own words, the prior art limits the user’s ability to change the *typography* of the stationery product. This does not encompass the limitation in Claim 5 of the present application. Claim 5 allows the user to change some of the *company-indicative information*. Company-indicative information is the content to be printed;

typography is the way in which the content is printed. The SEC filing seems to teach away from such end user control of any company-indicative information by discussing the ability to make and enforce global changes from a centralized management point of view; the Applicant's invention clearly allows the flexibility to be defined differently for each client company. Therefore, Applicant asserts that by the Examiner's interpretation of the prior art, Claim 5 is not disclosed and hence not obvious. The limitation of Claim 5 will be incorporated into Claim 1 to overcome the rejection. Applicant also submits that this amendment renders Examiner's rejections of claims dependent on Claim 1 ineffective. In addition, since this limitation is already incorporated into Claim 21, it and its dependent claims should also be allowed.

In addition, Applicant respectfully disagrees with the Examiner's Official Notice regarding server-side scripting used to reject Claim 14 and regarding server-side scripting implementing a logon security protocol used to reject Claim 15. It is necessary to adequately define the art to which the currently claimed invention belongs. One skilled in the art of printing would not have known server-side scripting such as Active Server Pages or HTML programming or scripting on the internet. As the art developed, the need for such knowledge also developed. Hence, the online print request services developed. But, at the time of invention, such knowledge was not within the scope of information one skilled in the relevant art would know. Applicant asserts that the Examiner is applying hindsight to conclude that the concepts in Claim 14 and 15 were within the knowledge of one of ordinary skill in the printing arts at the time of the invention. Applicant has incorporated the limitations of Claims 14 and 15 into Claim 1 and into Claim 21.

Applicant also respectfully takes issue with the Examiner's over-reliance on the SEC filing. An SEC filing is intended to be a document to guide an investor in his decision whether

to purchase the security of a particular company. In this respect, it differs significantly from a technical publication. Much of what is disclosed in an SEC filing discusses the future business plans of the organization, rather than the current capabilities of the corporation. As such, a prior art reference's expansive predictions about its own significance should not always be taken at face value. In re Bell, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993). Therefore, the disclosures encompassed in the SEC filing should not be taken at their face value as being a patentability-defeating disclosure as intended by the Patent statutes. In this case, Applicant would assert that the SEC filing does nothing to put the inventive concept within the grasp of the general public; it does not enable the full extent of the concepts it purports to disclose. Furthermore, the true extent of what ImageX.com actually believes to be its inventive concept (or that of its assignor inventors) is encompassed in the Lavery reference, which Applicant firmly believes has been antedated by his prior submitted affidavits.

Based on the foregoing amendments and arguments, Applicant respectfully requests that the Examiner withdraw all § 103 rejections.

### ***Effectiveness of Rodriguez and Lopez Affidavits***

In the July 18, 2005 Office Action, the Examiner found the previously submitted affidavits ineffective to establish conception, due diligence, or actual reduction to practice. The Applicant respectfully asserts that a showing of an actual reduction to practice, without a showing of conception, is sufficient to antedate a prior art reference. To establish an actual reduction to practice requires a showing that the process actually worked for its intended purpose. Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1578 (Fed. Cir. 1996). The inventor must show independent corroborating evidence in addition to his or her own documents, such as

testimony of a witness other than the inventor or evidence of surrounding facts and circumstances independent of information received from the inventor. Markman v. Lehman, 987 F. Supp. 25, 30 (D.D.C. 1997).

With the aforementioned affidavits, Applicant has met the requirements established by Mahurkar and Markman. While the Examiner makes good arguments as to why the Applicant's methods of recording and documenting his invention during the period are not "best practices" (i.e. lack of unit testing, string testing, user acceptance testing, etc...), it is not necessary for the Applicant to show best practices. It is only necessary to show that the invention has been demonstrated that it will work for its intended purpose. King Instrument Corp. v. Otari Corp., 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985).

Furthermore, Applicant is a small business owner engaged in the commercial printing business; his primary business is not in software development. Applicant's lack of a formal software development methodology, which could ensure detailed documentation of all stages of software development, should not be held against him.

Based on these arguments, Applicant respectfully requests that the Examiner reconsider the affidavits as filed. Furthermore, Applicant requests that the errors as to form of the affidavits (e.g. lack of NAFTA/WTO allegation) be held in abeyance pending Examiner's reconsideration.

### ***Conclusion***

In view of the foregoing arguments, Applicants respectfully ask that all rejections be withdrawn. Believing that all things raised in the Examiner's July 18, 2005 office action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Appl. No. 09/487,387  
Amdt. dated January 6, 2006  
Reply to Office Action of July 18, 2005.

Respectfully,

A handwritten signature in black ink, appearing to read "Charles W. Hanor", with a long horizontal flourish extending to the right.

Charles W. Hanor

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